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Brian Acton

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EXAMINER

DUNHAM, JASON B

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,837

Applicant(s)

ACTON ET AL.

Examiner

JASON B. DUNHAM

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 47-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 47-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 9/26/07, 12/5/07, 1/22/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant amended claim 1, cancelled claims 25-46, and added claims 47-69 in the response filed January 7, 2008. Cancellation of claims 25-46 rendered the previous 37 CFR 1.75(c) objection moot. The examiner notes that applicant indicated in their remarks that claims 24-46 were cancelled, however claim 24 remains in the listing of claims and therefore the objection to this claim stands.

Claim Objections

Claim 24 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim purports to be an apparatus claim, yet it is recited as being dependent on claim a method claim. Accordingly, the claims do not further limit the steps recited in the independent method claims, and are improper.

In order for a claim to be properly dependent, it must pass the "Infringement Test," that is, it shall not conceivably be infringed by anything which would not also infringe the basic claim (MPEP 608.01(n)). In the instant case, claim 24 could conceivably be infringed by systems that set forth the claimed structure. However, these systems would not necessarily infringe on the method claimed in claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-9, 11-24, 47-52, 54-55, and 57-69 are rejected under 35

U.S.C. 103(a) as being unpatentable over Bailey (US 2002/0062258) in view of Musgrove (US 7,082,426).

Referring to claim 1. The combination of Bailey and Musgrove discloses a method for associating data with product abstractions comprising the steps of:

- Inspecting a first data set that includes data that corresponds to an offer to sell a particular product by a particular party (Bailey: abstract);
- Based on the first data set, assigning said particular product to a product category (Musgrove: abstract, column 24, lines 27-53, and column 35, lines 4-8); and
- Matching said first data set with a product abstraction based, at least in part, on the product category to which said particular product corresponds (Bailey: abstract and paragraph 38).
- Wherein the product abstraction is an electronic representation of a product (Bailey: paragraph 38). The examiner notes that applicant's specification defines a product abstraction as a record in a database describing a product. The product attributes of Bailey discloses record describing a product.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have to modified the method of Bailey to have included assigning products to categories, as taught by Musgrove, in order to create product specifications based on the determined product attributes and determined category (Musgrove: abstract).

Referring to claim 2. The combination of Bailey and Musgrove further discloses a method wherein said offer to sell a particular product by a particular party is a first product offering of a plurality of product offerings and said product abstraction is one of plurality of product abstractions and each product abstraction is associated with one or more product categories comprising the steps of:

- Generating mapping information associating each product offering in said plurality of product offerings with one or more product abstractions in the plurality of product abstracts (Bailey: paragraphs 3 and 38);
- Receiving a query (Bailey: paragraph 3); and
- Generating a result set for the query based on said mapping information (Bailey: paragraph 3).

Referring to claim 3. The combination of Bailey and Musgrove discloses a method as referenced above in the rejection of claims 1 and 2 and further discloses a method comprising the steps of:

- Charging a party associated with a particular referenced entity in the result set based at least in part on inclusion of said particular referenced entity in said result set (Bailey: paragraph 139); and

- Determining how much to charge the party based, at least in part, on a product category associated with said referenced entity (Bailey: paragraph 139).

Referring to claim 4. The combination of Bailey and Musgrove further discloses a method wherein the result set is a list of one or more references (Bailey: paragraph 3).

Referring to claim 5. The combination of Bailey and Musgrove further discloses a method wherein each reference of the list of references corresponds to a referenced entity, and wherein each referenced entity associated with each reference in the list of references is one of a product abstraction (Bailey: paragraph 3).

Referring to claim 6. The combination of Bailey and Musgrove further discloses a method wherein the step of matching said first data set with a product abstraction comprises the steps of:

- Determining that said first data set does not correspond to any product abstractions in a plurality of existing product abstractions (Bailey: paragraphs 38-39);
- Generating a new product abstraction based on said first data set (Bailey: paragraph 38-39); and
- Matching said first data set with said new product abstraction (Bailey: paragraphs 38-39).

Referring to claim 8. The combination of Bailey and Musgrove further discloses a method wherein said result set includes a particular reference to a particular referenced entity, and wherein the method comprises the steps of:

- Providing said one or more result sets to one or more users (Bailey: paragraph 3); and
- Monitoring the number of times that said one or more users select said particular reference associated with said particular referenced entity from said one or more result sets (Bailey: paragraph 44).

Referring to claim 9. The combination of Bailey and Musgrove further discloses a method comprising the step of charging a party associated with said particular referenced entity a fee based on the number of times said one or more users select said particular reference (Bailey: paragraph 139).

Referring to claim 11. The combination of Bailey and Musgrove further discloses a method wherein the step of generating a result set comprises generating a page that contains one or more attributes of one or more products in one or more particular product categories (Bailey: figure 9a).

Referring to claim 12. The combination of Bailey and Musgrove further discloses a method wherein the step of generating a result set comprises generating a page which contains a comparison of one or more attributes of one or more entities that are referenced in the page with one or more attributes of one or more other entities that are referenced in the page (Bailey: figure 9a).

Referring to claim 13. The combination of Bailey and Musgrove further discloses a method comprising the step of providing to a party associated with said particular referenced entity, activity reports based on information generated during the step of

monitoring the number of times said one or more users selects the reference associated with said particular referenced entity (Bailey: paragraph 139).

Referring to claim 14. The combination of Bailey and Musgrove further discloses a method wherein said list of references comprises a plurality of references, and wherein the method comprises the steps of:

- Displaying said plurality of references in a particular order within said result set (Bailey: figure 9a);
- Determining said particular order based on a set of aspects of each reference in said plurality of references and a set of aspects of each referenced entity to which each reference in said plurality of references refers, wherein the aspects comprise one or more likelihood that a reference satisfies a query, existence of sponsorship, and cost of sponsorship (Bailey: figure 9a and paragraph 95).

Referring to claim 15. The combination of Bailey and Musgrove further discloses a method wherein the step of generating the result set comprises the steps of:

- Applying a similar measure between one or more aspects of a particular reference and one or more aspects of a plurality of other references, wherein said aspects include one or more aspects of the reference and one or more aspects of the referenced entity (Bailey: paragraph 76); and
- Selecting which references to include in said result set based on said similarity measure (Bailey: paragraph 76).

Referring to claim 16. The combination of Bailey and Musgrove further discloses a method wherein the step of matching said first data set with a product abstraction

comprises the step of comparing an identifier corresponding to said product abstraction to an identifier corresponding to said first data set (Bailey: paragraph 31).

Referring to claim 17. The combination of Bailey and Musgrove further discloses a method wherein the identifier is chosen from the group consisting of UPC, ISBN, manufacturer, manufacturer's part number, and model number (Bailey: paragraph 31).

Referring to claim 18. The combination of Bailey and Musgrove further discloses a method wherein the step of determining a product category to which said particular products corresponds comprise the step of comparing an identifier corresponding to said product category to an identifier corresponding to said first data set (Bailey: paragraphs 43 and 77).

Referring to claim 19. Claim 19 is rejected under the same rationale set forth above in the rejection of claim 17.

Referring to claim 20. The combination of Bailey and Musgrove further discloses a method wherein the product category maps to one or more products abstractions, merchants, product offerings, and other product categories (Bailey: paragraph 38).

Referring to claim 21. The combination of Bailey and Musgrove further discloses a method comprising the step of obtaining product information for said first set of data by extracting the product information from an electronic catalog (Bailey: paragraph 3).

Referring to claim 22. The combination of Bailey and Musgrove further discloses a method comprising the step of obtaining product information for said first set of data by crawling web sites over the Internet (Bailey: paragraph 37).

Referring to claim 23. The combination of Bailey and Musgrove discloses a method as referenced above in the rejection of claims 1 and 2 and further discloses a method wherein said offer to sell a particular product by a particular party is a first product offering of a plurality of product offerings; said product abstraction is one of a plurality of product abstractions and each product abstraction is associated with one or more product categories; and the method comprising the steps of:

- Generating mapping information associating each product offering in said plurality of product offerings with one more product abstractions in the plurality of product abstractions (Bailey: paragraphs 3 & 38);
- Revising said mapping information, wherein the step of revising comprises one or more of the following steps: changing a data set (Bailey: paragraph 38).

Referring to claims 24, 47-52, 54-55, and 57-69. Claims 24, 47-52, 54-55, and 57-69 are rejected under the same rationale set forth above.

Claims 7 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bailey and Musgrove in view of Gavarini (US 2006/0184430).

Referring to claim 7. The combination of Bailey and Musgrove discloses all of the above but does not expressly disclose generating a new product category after determining that a first data set does not correspond to any existing product categories. Gavarini disclose a method for associating data with product abstractions wherein the

step of determining, based on a first data set, a product category to which a particular product corresponds further comprises the steps of:

- Determining that said first data set does not correspond to any product category in a plurality of existing product categories (Gavarini: paragraph 78);
- Generating a new product category based on said first data set (Gavarini: paragraph 78); and
- Associating said first data set with said new product category (Gavarini: paragraph 78).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bailey/Musgrove to have included generating a new product category after determining that a first data set does not correspond to any existing product categories, as taught by Gavarini, in order to customers to define search queries under user-defined categories (Gavarini: abstract).

Referring to claim 53. Claim 53 is rejected under the same rationale set forth above in the rejection of claim 7.

Claims 10 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey and Musgrove in view of Scholl (US 2005/0149390).

Referring to claim 10. The combination of Bailey and Musgrove discloses all of the above but does not expressly disclose generating a page that contains one or more sponsored and unsponsored references. Scholl discloses a method for associating

data with product abstractions wherein the step of generating a result set further comprises generating a page that contains one or more sponsored references and one or more unsponsored references, wherein a sponsored reference is a first reference associated with a first referenced entity, and for which a first party associated with said first referenced entity is charged for each inclusion of said first reference in said one or more result sets, and wherein an unsponsored reference is a second reference for which no party will be charged for each inclusion of said second reference in said one or more result sets (Scholl: paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Bailey/Musgrove to have included generating a page that contains one or more sponsored and unsponsored references, as taught by Scholl, in order to identify advertisement and search term combinations for placing advertisements along with search terms (Scholl: abstract).

Referring to claim 56. Claim 56 is rejected under the same rationale set forth above in the rejection of claim 10.

Response to Arguments

Applicant's arguments filed June 7, 2008 have been fully considered but they are not persuasive. The abstract of Bailey discloses, "Based on the user selection of the item category using the client system, one or more attributes associated with all items in the item are provided. Based on user input identifying an attribute value for at least one attribute, search results including one or more items matching the attribute value are

generated." After a user has inspected the search results (i.e. first data set), the user can select an item for order. The examiner submits that placing an order for an item by selecting it anticipates an offer to sell the item to the user (i.e. particular party). Furthermore, the examiner notes that the cited portions of the prior art noted in the 35 USC 102 and 103 rejections are not intended to be limiting, the prior art must be considered as a whole. Paragraph 139 of Bailey further discloses that the search results are intended to be used in an e-commerce environment directed towards selling products. Finally, applicant argues that the combination of Bailey and Musgrove does not disclose the limitation of matching said first data set with a product abstraction based on the product category. The examiner disagrees because paragraph 38 of Bailey discloses specifying a category of an item and then presenting a predetermined list (i.e. matching) of attributes (i.e. product abstractions).

Applicant further argues that the combination of Bailey and Musgrove does not disclose "charging a party associated with a particular referenced entity in the result set based at least in part on inclusion of said particular referenced entity in said result set", as recited in claim 3. The examiner disagrees because paragraph 139 of Bailey discloses charging a user (party) a fee for completing a transaction for an item (particular referenced entity) included in the result set.

The rationale noted above for the rejection of independent claims 1 and 3 is also applicable for independent claims 23, 24, medium claims 47-69, and dependent claims 2 and 4-22.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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4/7/08